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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

IYER et al.

Serial No. 09/581,122

Filed: June 15, 1998

Art Unit: unassigned

Examiner: unassigned

Attorney Docket No.: 98-503-US

FETAL OXIMETRY SYSTEM  
AND SENSOR

Pittsburgh, Pennsylvania 15230

**RENEWED PETITION UNDER 37 C.F.R. § 1.47(a) TO  
EXECUTE APPLICATION FOR NON-SIGNING INVENTORS**

BOX PCT  
Commissioner for Patents  
Washington, DC 20231

Sir:

Applicants Vijah K. Iyer, Christopher A. Cutler,  
William D. Wallace, Steven R. Smith, Daniel J. McGraw,  
Clifford G. Montagnoli and Trent W. Banks, joint inventors of  
the above-identified invention, hereby respectfully request  
authorization to execute the subject patent application under  
37. C.F.R. § 1.47(a) on behalf of joint inventors Robert M.  
Johnson, Johannes Buschmann, Reinhold Falkowski and Nick Tu, who  
after diligent effort cannot be found to join in this  
application.

# I. Proof of Pertinent Facts

As evidenced by the Declaration of Cheryl L. Gastineau ("Ms. Gastineau"), agent for Applicants, a copy of which is attached hereto as Attachment 1, Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski and Nick Tu have not been found to join in the U.S. application and execute the Declaration after reasonable and diligent efforts were taken.

## II. The Action Is Necessary To Preserve The Rights Of The Parties Or Prevent Irreparable Harm

To execute the subject application the combined Declaration and Power of Attorney document must be signed and filed. As demonstrated above, Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski and Nick Tu cannot be found to sign the declaration document. Thus, to prevent the subject application from being abandoned and to otherwise to protect the other joint inventors and Assignee Respireonics, Inc.'s patent rights, it is necessary for the other joint inventors to execute the subject application on behalf of Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski and Nick Tu under 37. C.F.R. § 1.47(a).

## III. Last Known Address of Non-Signing Inventors

Robert M. Johnson  
481 Ivy Park Lane  
Atlanta, GA 30342

Johannes Buschmann  
Birkenleiten 9  
D81453 Munich  
Federal Republic of Germany

Reinhold Falkowski  
Birkenleiten 9  
D81453 Munich  
Federal Republic of Germany

Nick Tu  
444 South Ivy Drive  
Midvale, Utah 84047  
and  
8188 Ivy Drive,  
Midvale, Utah 84047

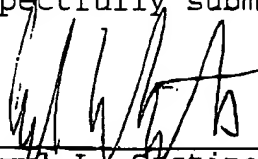
#### IV. Conclusion

For the reasons presented above, Applicants respectfully submit that Robert M. Johnson, Johannes Buschmann, Reinhold Falkowski and Nick Tu, who are believed to be inventors in the above-identified U.S. application cannot be found to execute the application, as set forth in the Declaration of Ms. Gastineau at Attachment 1.

Accordingly, Applicants respectfully request the authorization under 37. C.F.R. § 1.47(a) to file the above-identified U.S. application on behalf of the non-signing joint inventors, Robert M. Johnson, Johannes Buschmann, Reinhold

Falkowski and Nick Tu, be granted and that a Notice to that effect be provided.

Respectfully submitted,



Dated: November 13, 2001

---

Cheryl L. Gastineau  
Reg. No. 39,469

REED SMITH LLP  
P.O. Box 488  
Pittsburgh, PA 15230  
(412) 288-4152

Agent for Applicants

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PCT Patent Application of:

IYER et al.

Serial No.: 09/581,122

Filed: June 15, 1998

Art Unit: unassigned

Examiner: unassigned

Atty. Docket No.: 98-503-US

FETAL OXIMETRY SYSTEM  
AND SENSOR

BOX PCT  
Commissioner for Patents  
Washington, D.C. 20231

DECLARATION OF MS. CHERYL L. GASTINEAU

Sir:

I am a patent agent with Registration No. 39,469 with  
Reed Smith LLP, P.O. Box 488, Pittsburgh, Pennsylvania 15230.

Robert M. Johnson

On March 29, 2001, I sent Robert M. Johnson  
("Mr. Johnson") a letter via first class mail to Robert M.  
Johnson, 481 Ivy Park Lane, Atlanta, GA 30342. The letter  
requested he sign and date an enclosed Combined Declaration and  
Power of Attorney ("Declaration") for the above-identified patent  
application and to return said Declaration to me no later than  
one week from receipt in an enclosed "prepaid postage" envelope.

The letter was returned by the United States Postal Service as "RETURNED TO SENDER UNDELIVERABLE AS ADDRESSED UNABLE TO FORWARD." On September 24, 2001, I sent Mr. Johnson a package via U.S. Express Mail. Included in the package was a cover letter (Exhibit A), a Declaration and copy of the above-identified patent application. The package was returned as "RETURNED TO SENDER UNDELIVERABLE AS ADDRESSED UNABLE TO FORWARD." (Exhibit B)

Johannes Buschmann

On March 29, 2001, I sent Johannes Buschmann ("Mr. Buschmann") a letter via first class mail to Johannes Buschmann, Birkenleiten 9, D-81453 Munich, Federal Republic of Germany. The letter requested he sign and date an enclosed Combined Declaration and Power of Attorney ("Declaration") for the above-identified patent application and to return said Declaration to me no later than one week from receipt in an enclosed "prepaid postage" envelope. I mailed a second request on May 31, 2001 to Mr. Buschmann at Birkenleiten 9, D-81453 Munich, Federal Republic of Germany and also faxed to him a request at No. 011-49-89-680-6650. On September 24, 2001, I sent Mr. Buschmann a package via DHL. Included in the package was a cover letter (Exhibit C), a Declaration and copy of the above-identified patent application. As of November 12, 2001, I have not received any correspondence from Mr. Buschmann.

Reinhold Falkowski

On March 29, 2001, I sent Reinhold Falkowski ("Mr. Falkowski") a letter via first class mail to Reinhold Falkowski, Birkenleiten 9, D-81453 Munich, Federal Republic of Germany. The letter requested he sign and date an enclosed Combined Declaration and Power of Attorney ("Declaration") for the above-identified patent application and to return said Declaration to me no later than one week from receipt in an enclosed "prepaid postage" envelope. I mailed a second request on May 31, 2001 to Mr. Falkowski at Birkenleiten 9, D-81453 Munich, Federal Republic of Germany and also faxed to him a request at No. 011-49-89-680-6650. On September 24, 2001, I sent Mr. Falkowski a package via DHL. Included in the package was a cover letter (Exhibit D), a Declaration and copy of the above-identified patent application. As of November 12, 2001, I have not received any correspondence from Mr. Falkowski.

Nick Tu

I sent Mr. Nick Tu ("Mr. Tu") at the address of 444 South Ivy Drive, Midvale, UT 84047 a letter dated January 18, 2001. Enclosed with the letter in an envelope was a copy of U.S. Patent Application No. 09/581,122 and a Combined Declaration and Power of Attorney ("Declaration") to be executed by Mr. Tu for said application. Also enclosed was an Assignment of Mr. Tu's inventorship rights to the invention in the above-referenced application to the Applicant, Respironics, Inc. The letter



requested Mr. Tu to sign and date both the Declaration and the Assignment and return them no later than one week after receipt.

The envelope was returned to us unopened on January 29, 2001 and stamped with the message "RETURN TO SENDER, NO SUCH NUMBER."

My secretary searched the internet and found a Nicholas Tu at 8188 Ivy Drive, Midvale, UT 84047. We remailed the contents of the previously identified envelope on January 30, 2001. We sent an additional request to Nicholas Tu at 8188 Ivy Drive, Midvale, UT 84047 on May 31, 2001. On September 24, 2001, I sent Mr. Tu a package via U.S. Express Mail. Included in the package was a cover letter (Exhibit E), a Declaration and copy of the above-identified patent application. The package was returned as "RETURN TO SENDER UNCLAIMED" (Exhibit F). As of November 12, 2001, I have not received any correspondence from Mr. Tu.

On April 30, 2001, I contacted Leila Mobley of Respironics, Inc. to inquire if she could provide different addresses for the above-identified inventors. She contacted me on May 11, 2001 to indicate she could not find different addresses for the above.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false

statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: November 13, 2001Name: Cheryl L. GastineauTitle: Patent AgentSignature: 

**ReedSmith**

Cheryl L. Gastineau • 412.288.4152 • cgastineau@reedsmith.com

September 24, 2001

VIA EXPRESS MAIL

Mr. Robert M. Johnson  
481 Ivy Park Lane  
Atlanta, GA 30342

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Johnson:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced U.S. patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Falkowski, Cutler, Wallace, McGraw, Smith, Tu, Montagnoli and Banks.

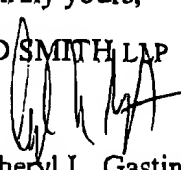
Please sign and date the enclosed Combined Declaration and Power of Attorney where indicated by the red markers. Also enclosed is a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.

Kindly return the signed Declaration to me as soon as possible. For your convenience, I have enclosed a self-addressed U.S. Post Office Express Mail Label and envelope. Simply place the executed document in the Express Mail envelope, and drop the envelope in any U.S. Postal Service Mail box. All charges for the mailing will be paid for by Respironics. Please note that the mailing materials that I have sent for your convenience require no effort to return other than placing them in your regular outgoing regular U.S. mail.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By   
Cheryl L. Gastineau  
CLG:dj

Encs.: Declaration  
U.S. Serial No. 09/581,122  
Express Mail Label and Envelope  
cc: Michael W. Haas, Esq. (w/enc.)  
Frederick H. Colen, Esq. (w/o enc.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063

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Cheryl L. Gastineau • 412 • 4152 • cgastineau@reedsmith.com

September 24, 2001

VIA DHL

Mr. Johannes Buschmann  
Birkenleiten 9  
D-81453 Munich  
Federal Republic of Germany

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Buschmann:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Falkowski, Johnson, Cutler, Wallace, Smith, McGraw, Tu, Montagnoli and Trent.

Please sign and date the Combined Declaration and Power of Attorney where indicated by the red markers. Also enclosed is a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.


Kindly return the signed document to me as soon as possible. For your convenience, I have enclosed a self-addressed DHL label and envelope. Simply place the executed document in the DHL envelope, and take to a DHL drop-off location to return to us. All charges for the mailing will be paid for by Respironics.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By

  
Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

U.S. Serial No. 09/581,122

DHL Label and Envelope

cc: Michael W. Haas, Esq. (w/enc.)

Frederick H. Colen, Esq. (w/o enc.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063

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**ReedSmith**

Cheryl L. Gastineau • 412.288.4152 • cgastineau@reedsmith.com

September 24, 2001

VIA DHL

Mr. Reinhold Falkowski  
Birkenleiten 9  
D-81453 Munich  
Federal Republic of Germany

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Falkowski:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Johnson, Cutler, Wallace, Smith, McGraw, Tu, Montagnoli and Trent.

Please sign and date the Combined Declaration and Power of Attorney where indicated by the red markers. Also enclosed is a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.

Kindly return the signed document to me as soon as possible. For your convenience, I have enclosed a self-addressed DHL label and envelope. Simply place the executed document in the DHL envelope, and take to a DHL drop-off location to return to us. All charges for the mailing will be paid for by Respironics.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By

  
Cheryl L. Gastineau

CLG:dl

Encs.: Declaration

U.S. Serial No. 09/581,122

DHL Label and Envelope

cc: Michael W. Haas, Esq. (w/enc.)

Frederick H. Colen, Esq. (w/o enc.)

435 Sixth Avenue  
Pittsburgh, PA 15219-1886  
412.288.3131  
Fax 412.288.3063

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**ReedSmith**

Cheryl L. Gastineau • 412.288.4152 • cgastineau@reedsmith.com

September 24, 2001

**VIA EXPRESS MAIL**

Mr. Nick Tu  
8188 Ivy Drive  
Midvale, UT 84047

Re: U.S. Patent Application of IYER, et al.  
Serial No. 09/581,122  
For "FETAL OXIMETRY SYSTEM AND SENSOR"  
Respironics Ref. No. 97-30  
Our Ref.: 98-503-US

Dear Mr. Tu:

Michael Haas of Respironics, Inc. has asked that I write to you concerning the above-referenced U.S. patent application that has been filed on their behalf in your name as an inventor, as well as in the names of Messrs. Iyer, Buschmann, Falkowski, Johnson, Cutler, Wallace, McGraw, Smith, Montagnoli and Banks. Although we understand that you have refused in the past to sign documents regarding the related International application, we have been required by the Patent and Trademark Office to try to obtain your signature on the papers related to the filing of the U.S. application.

Please sign and date the enclosed Combined Declaration and Power of Attorney where indicated by the red markers. Also enclosed is a copy of U.S. Serial No. 09/581,122 including the specification, claims and drawings.

Kindly return the signed Declaration to me as soon as possible. For your convenience, I have enclosed a self-addressed U.S. Post Office Express Mail Label and envelope. Simply place the executed document in the Express Mail envelope, and drop the envelope in any U.S. Postal Service Mail box. All charges for the mailing will be paid for by Respironics. Please note that the mailing materials that I have sent for your convenience require no effort to return other than placing them in your regular outgoing regular U.S. mail.

Should you have any questions, please do not hesitate to call me at (412) 288-4152. Otherwise, I look forward to receiving the executed document within the next several days.

Very truly yours,

REED SMITH LLP

By

  
Cheryl L. Gastineau

CLG:dl

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U.S. Serial No. 09/581,122  
Express Mail Label and Envelope

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Mr. Nick Tu  
September 24, 2001  
Page 2

Reed Smith LLP

cc: Michael W. Haas, Esq. (w/enc.)  
Frederick H. Colen, Esq. (w/o enc.)

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Ser. No. 09/581,122

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FETAL OXIMETRY SYSTEM  
AND SENSOR

Renewed Petition under 37  
CFR Section 1.47(a) to  
Prosecute Application  
for Non-Signing

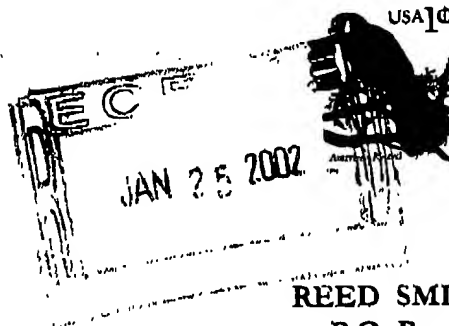
Inventors  
Declaration of Ms. Cheryl  
L. Gastineau (Exs. A-F)  
Letter

Combined Declaration and  
Power of Attorney of Mr.  
Steven R. Smith

Combined Declaration and  
Power of Attorney of Mr.  
Clifford G. Montagnoli

09/124/02

JC14 Rec'd PCT/PTO 14 JAN 2002



REED SMITH SHAW & McCLAY  
P.O. Box 488  
Pittsburgh, Pennsylvania 15230

ATTN: *Jody Bartner*  
*M. Cohen*





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 Cheryl L. Gastineau  
 Reed Smith LLP  
 435 6th Avenue  
 Pittsburgh, PA 15219

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PHONE ( )

 Mr. Robert M. Johnson  
 ART Two Dark Lane


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PHONE: 412, 288-4152

Cheryl L. Gastineau  
 Reed Smith LLP  
 435 6th Avenue  
 Pittsburgh, PA 15212

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TO: (PLEASE PRINT)

PHONE: [Blank]

Mr. Nick Tu  
 8188 Ivy Drive  
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